

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Petra Cirpus et al.

Application No.: 10/552127

Confirmation No.: 6201

Filed: October 5, 2005

Art Unit: 1638

For: Δ -4 Desaturases From *Euglena Gracilis*,
Expressing Plants, And Oils Containing PUFA

Examiner: McElwain, Elizabeth F.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed December 11, 2007, Applicants hereby provisionally elect Group I, claims 1-3 and 5-16, for further prosecution with traverse. Reconsideration and withdrawal of the restriction requirement is strongly urged for the following reasons.

The Claimed Inventions Share a Special Technical Feature

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. An application “shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.” (PCT Rule 13.1). Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression ‘special technical feature’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner alleges that these groups lack unity because the inventions of Groups II and III do not require the delta-4 desaturase coding sequence of Group I. The Examiner further alleges that the nucleic acid of Group I does not share a special technical feature with the polypeptide of Group II. Additionally, the Examiner asserts that the product of Group III do not comprise either the nucleic acid of Group I or the amino acid sequence of Group II and each is chemically, structurally and functionally distinct. Applicants respectfully disagree with the Examiner's characterization of the claims.

As stated in the specification, the general inventive concept of the present application relates to a novel delta-4 desaturase coding sequence and its use for the production of polyunsaturated fatty acids in an organism. See Specification at page 3, lines 14-19. The Examiner has not pointed to any reference disclosing the delta-4 desaturase coding sequences of the present application. Thus, it is respectfully submitted that the common technical feature of the present claims defines a contribution over the prior art.

Moreover, Applicants believe that there is no undue burden on the Examiner to search all Groups together. As stated in § 803 of the M.P.E.P. "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added). As discussed above, all of the Restriction Groups share a common feature of a novel delta-4 desaturase coding sequence. Thus, the same art and field of search relevant to Group I would be also relevant to Group II and III. No undue burden would be required in examining them together. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examiner all the claims in one application.

The International Examiner Found Unity of Invention

Furthermore, unity of invention was found during the International stage. As shown in the International Preliminary Report on Patentability and International Search Report, all claims were searched and examined together. Thus, application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists. Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, for this additional reason, there would be no undue burden on the Examiner to examine all Groups in one application.

CONCLUSION

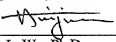
For the above reasons, Applicants respectfully request reconsideration and withdrawal of this restriction requirement.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application, if necessary.

Applicants are submitting their response within the one-month response period. No fee is believed due. However, if any fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 12810-00136-US from which the undersigned is authorized to draw.

Respectfully submitted,

By


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